

REMARKS

During a telephone interview today, Examiner Fischer determined that claims 42-51 and 62 would be considered and examined in the present patent application. This is because the step of "irradiating a substrate with near infrared light, with some of the light being absorbed by said substrate" is recited in claim 42 lines 14-17. Applicants elect claims 42-51 and 62, with traverse.

Claims 62 was rejected under 35 USC 112, first paragraph because claim 62 recites a "resilient sheet" and the Examiner questioned support for this language in the specification. The specification page 9 lines 17-21 recites "Pressure buffer 14 is provided to avoid this imperfect connection, while **still possessing enough elasticity** to enable even planar pressure to be applied to the compressively bonded surfaces. **A material such as one based on silicon rubber, an aramide tape or a polyimide film (e.g. Kapton made by E.I. du Pont de NeMours & Company)** can be used for buffer 14." This provides support for a "resilient sheet" as recited in claim 62.

Claim 62 was rejected under 35 USC 112, second paragraph, because of the recitations of "said color filter" and "said polarizer" in the second to last paragraph of claim 62. Correction has been made above by providing antecedent basis earlier in claim 62.

Claim 62 was rejected under 35 USC 103 based on Uchiyama, APA, Oxman and Tagusa. Applicants hereby traverse this rejection based on the following. The Examiner acknowledges that none of these references teaches the following step of claim 62:

"during the steps of heating said block and applying heat to said opposite face of said substrate, cooling a portion of said resilient sheet peripheral to said IC chip adjacent to said color filter and said polarizer to reduce indirect heating of said color filter and said polarizer from said block via said resilient sheet."

The following limitation has been added to claim 62 above:

“wherein the step of cooling comprises the step of discharging a gas against said portion of said resilient sheet peripheral to said integrated circuit adjacent to said color filter and said polarizer.”

The Examiner asserts that it would have been obvious to “cool that portion of the cushion member that is adjacent the filter and polarizer.” Applicants disagree. Even though there may be a need to cool the color filter and polarizer, it would not be obvious to accomplish this by cooling the resilient sheet, rather than by direct cooling of the color filter and polarizer. In fact, with the intimate connection of the resilient sheet to the IC chip and the tendency for the gas to blow along a face of the resilient sheet against the edge of the IC chip, there would be a temperature gradient at the edge of the IC chip, and it was not obvious that the cooling arrangement recited in claim 62 would work without damaging the IC chip.

The Examiner also asserts that “exposure to the environment (in the relevant region) would provide a cooling effect since the heating tool does not extend to the periphery of the filter and polarizer.” Amended claim 62 recites active cooling by discharge of gas to distinguish over negligible, incidental effects of the environment.

Claims 63 and 64 depend on claim 62.

Claim 42 distinguishes over the prior art for the same reasons that claim 62 distinguishes thereover. Claims 43-51 depend on claim 42.

RESPONSE TO RESTRICTION REQUIREMENT

The Examiner asserted

“restriction between independent claims 42 and 52 is applicable as the inventions are related as method and apparatus. In this instance, the apparatus can be used in a materially different method, such as one in which different electrical components are being adhered or one in which substrates different than those detailed in the claims invention are being adhered.”

Applicants respectfully traverse this restriction requirement and request reconsideration, based on the following.

The standard for Restriction, which determines whether or not the same invention is being claimed, is set forth in MPEP 802.01:

"Two or more inventions are related (i.e., not independent) if they are disclosed as connected in at least one of design (e.g., structure or method of manufacture), operation (e.g., function or method of use), or effect. Examples of related inventions include< combination and part (subcombination) thereof, process and apparatus for its practice, process and product made, etc. **>In< this definition the term related is used as an alternative for dependent in referring to *>inventions< other than independent *>inventions<.

>Related inventions are distinct if the inventions *as claimed* are not connected in at least one of design, operation, or effect (e.g., can be made by, or used in, a materially different process) and wherein at least one invention is PATENTABLE (novel and nonobvious) OVER THE OTHER (though they may each be unpatentable over the prior art). See MPEP § 806.05(c) (combination and subcombination) and § 806.05(j) (related products or related processes) for examples of when a two-way test is required for distinctness.<" (Emphasis in original)

Thus, there are two requirements for "distinctive" claims, i.e. they are related to each other **and one invention is PATENTABLE (novel and nonobvious) OVER THE OTHER.** (The first requirement is to ensure that the claims are not "independent" of each other, which is a different ground for restriction.)

The Examiner has not made a prima facie case that claims 42-51 were distinct from claims 52-61 because the Examiner has not explained why one set of claims was patentable over the other set; the Examiner did not even assert that one set of claims was patentable over the other set. Therefore, the restriction requirement should be withdrawn.

Based on the foregoing, Applicants request allowance of the present patent application as amended above.

Respectfully submitted,

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